

REMARKS

Claim Status

Claim 23 is now pending in the application. Claim 23 has been amended to recite that the beverage is carbonated (basis at page 18, beginning at line 18) and to remove the structural formula as being redundant, in view of the "sodium hexametaphosphate" already recited in the claim. The pH and sweetener recitations of Claims 28 and 25 have been added to Claim 23. All amendments are fully supported and entry is requested.

Rejections Under 35 USC 103

Claims 23-31 stand rejected under 35 USC 103(a) as being unpatentable over Kohl *et al.* (US 3,681,091).

Claims 23, 25, 28 and 30 are rejected under 35 USC 103(a) as being unpatentable over Calderas *et al.* (US 5,431,940) as evidenced by Grunberg *et al.* (Scandinavian Journal of Nutrition/Naringsforskning).

Applicants respectfully traverse the rejections in view of sole Claim 23, as now amended.

For the record, all previous arguments in support of patentability continue to apply, but will not be repeated herein for the sake of brevity.

At the outset, it must again be submitted that it is counter-intuitive and, hence, non-obvious, to use an acidic carbonated beverage of the present type to treat teeth that have been eroded by acid. The claimed method for treating dental erosion that has been caused by exposure of the teeth to acid requires a particular patient population and a particular phosphate agent in a carbonated beverage that is administered to such patient population at an acidic pH, none of which is explicitly or inherently disclosed by the combination of cited documents.

With regard to the combination of '940 with the Grunberg article, it is submitted that the §103 grounds for rejection is based on a legal presumption of inherency (Office Action, page 7, lines 1 and 2), since the cited references do not teach the claimed method with specificity.

Indeed, '940 focuses entirely on non-carbonated beverages, and is directed to providing improved microbial stability therein. See ABSTRACT; Column 1, first paragraph; column 2, line 60; Examples; and Claims.

Like '940, the '091 patent relates to certain phosphates to prevent microbial food spoilage. See column 1, lines 29-31.

Clearly, neither '940 nor '091 addresses the problem of dental erosion, nor evidences any recognition of the present process. Nonetheless, both §103 rejections infer inherency and are grounded on that supposition.

In that regard, the Examiner's attention is directed to the Board's decision in *Ex parte Schricker*, 56 USPQ2d 1723 (BPAI 2000).

With regard to an inherency rejection being under §102 or §103, the Board addresses this specific point at page 1725 [1]. The Board notes:

Inherency and obviousness are somewhat like oil and water – they do not mix well.

As stated by the Board at page 1725, five lines earlier, inherency, "... is really an anticipation rationale ..."

Furthermore, the Board additionally notes at page 1725 [1]:

However, when an Examiner relies on inherency, it is incumbent on the Examiner to point to the "page and line" of the prior art which justifies an inherency theory.

In that regard, the relevant case law also requires that:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999).

Moreover, it is improper to establish prior invention when there is an absence of evidence that the alleged prior inventors appreciated at the time of their work all the elements of the invention. *Schering Corp. v. Precision--Cosmet Co., Inc.*, 614 F. Supp. 1368, 227 USPQ 278 (D. Del. 1985).

Accordingly, it is respectfully submitted that §103 is not a proper grounds for the inherency rejections in the instant case. Withdrawal of the rejections on the basis of §103 is requested.

Even assuming *arguendo* that §103 is a proper grounds for rejection of the claim as now amended, it is submitted that the §103 rejection must fail, as a matter of law.

As noted above, the primary references, singly or in combination, in no way suggest, much less solve, the dental problem being addressed by the present invention. Yet, the particular problem facing the inventor must be considered in determining obviousness. It is error to focus solely on the product created, rather than on the obviousness or non-obviousness of its creation. Thus, the question is whether what the inventor did would have been obvious to one of ordinary skill in the art in attempting to solve the problem upon which the inventor was working. The problem solved by the invention is always relevant. *In re Wright*, 848 F.2d 1216, 6 U.S.P.Q. 2d 1959, 1961, 1962 (Fed. Cir. 1988); emphasis supplied.

In addition, when a person, having the references before him and not cognizant of Applicant's disclosure, would not be informed that a problem (solved by Applicant's claimed invention) ever existed, such references (which never recognized the problem) could not have suggested its solution. The references were thus improperly combined since there is no suggestion in either of them that they can be combined to produce the result obtained by the claimed invention. *In re Shaffer*, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956); emphasis supplied.

Supplemental IDS

Submitted herewith, along with the IDS form, is the Abstract of the Reussner article, previously discussed. Note that Reussner does relate to molar erosion but selects monocalcium phosphate as the treatment agent, rather than the phosphate of the present invention.

Net: In light of the controlling case law, the limitations to the specified phosphate/pl/carbonation elements now recited in the claim and the arguments presented, early and favorable action is requested.

Respectfully submitted,

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